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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,790	10/21/2003	Jay S. Walker	03-057	7570
22927	7590	03/03/2006	EXAMINER LEE, SEUNG H	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,790

Applicant(s)

WALKER ET AL.

Examiner

Seung H. Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20060228.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Additional Remarks

1. In response to the applicant requesting of supplemental/duplicate office action due to the missing parts (i.e., the office action and references), the Examiner hereby provide the duplicate copy of the office action mailed out on 24 February 2006 including missing reference.
2. Receipt is acknowledged of the response filed on 01 December 2005, which has been entered in the file. Claims 1 - 15 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1, 3, 4, 7, 8, 10, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montangero et al. (US 6,035,279, of record)(hereinafter referred to as 'Montangero') in view of Walker (WO 98/43149).

Re claims 1 and 15: Montangero teaches a method and a system for awarding prize for purchasing products comprises a cash terminal (10) supplying data (e.g., data

Art Unit: 2876

about the product to be purchased by a customer) to the central processing unit (12), a pseudo-random device (20) for generating/supplying a plurality of random outcomes (e.g., supplying/generating no signal or a win signal) for determining the winning code or a prize code using the predetermined condition stored in the memory (27) using a prize awarding device (26) (see figure; col. 1, line 53- col. 4, line 9).

However, Montangero fails to teach or fairly suggest that the method comprises a determining means for providing an upsell offer.

Walker teaches the POS terminal (1010) receiving product identifier via input device (1014) and generating an upsell offer based on the entered product identifier (see figs. 13A-16; page 39 3rd paragraph – page 48, 1st paragraph).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker to the teachings of Montangero in order to provide an user-friendly system for reducing the coins being exchange between the customer and the POS terminal by providing alternative by offering upsell items accordingly.

Re claims 3 and 4: A prize-awarding signal (28) of Montangero can be displayed using the indicating device (29) such as an indicator panel, television screen, etc. or forward to the cash terminal for indicating the winning purchased on a display (31) wherein the a code representing the prize is displayed thereon wherein the cash terminal also serve as an entertainment interface.

Re claims 7 and 8: The terminal of Montangero also comprises a reader (49) for reading a magnetic band (51) of the identification card (50) wherein the identification card is unique to each customer.

Re claim 10: The auxiliary device (14) of Montangero serves as a server computer generating the prize code and communicating the result to the cash terminal

Re claim 13 and 14: A memory devices (18, 22, 27) of the auxiliary device and a memory (not shown) of the cash terminal of Montangero store a program(s) or data in order to execute the necessary transaction of prize awarding functions.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montangero as modified by Walker as applied to claim 1 above, and further in view of Sleeper (US 6,401,074, of record).

The teachings of Montangero/Walker have been discussed above.

Although, Montangero/Walker teach the method for providing the upsell offering terminal at retail transaction system according to the products to be purchased, they fail to particularly teach or fairly suggest that the product identifiers are barcodes on the product.

Sleeper teaches a retail transaction system comprising a POS (point of sale) system as shown in figure 1 having a scanner (112) for scanning barcode of the items to be purchased wherein the barcode serves as a product identifier (see figs. 1-5; col. 2, line 42- col. 3, line 48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sleeper to the teachings of Montangero/Walker in order to provide automated checkout-processing system by using the well-known barcode symbology for identifying the product associated with the barcode therewith.

6. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montangero as modified by Walker as applied to claim 1 above, and further in view of Burke (US 5,848,399, of record).

The teachings of Montangero/Walker have been discussed above.

Although, Montangero/Walker teach the method for providing the terminal at retail transaction system for purchasing products by the purchasers, they fail to particularly teach or fairly suggest that the terminal is displaying an image of the products according to the product identifier.

However, Burke teaches a method of a shopping service comprising a method of sending UPC information (55) for particular product and receiving an image of the products (54) (see figs. 1, 5; col. 3, line 49- col. 5, line 21; col. 6, lines 12- 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Burke to the teachings of Montangero/Walker in order to verify/identify the product to be purchased by the customer with the price and product visually, that is, the POS terminal display the

products images associated with the identifier on the display then the customer/operator can verify the actual product to be purchased with images of the products.

7. Claim 5, 6, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montangero as modified by Walker and Burke, and further in view of Cohen et al. (US 5,373,440, cited by applicant)(hereinafter referred to as 'Cohen').

The teachings of Montangero/Walker/Burke have been discussed above.

Although, Montangero/Walker/Burke teach the method for providing the terminal at retail transaction system displaying an image of the products to be purchased, they fail to particularly teach or fairly suggest that the image is provided as an indicia on a virtual slot machine reel or entertainment interface.

However, Cohen teaches a game machine (10) comprising a screen (14) for displaying images (17 or 19) on the plurality of wheels (16, 18, and 20) (see figs. 1, 4, and 5; col. 5, line 14- col. 10, line 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cohen to the teachings of Montangero/Walker/Burke in order to provide a user friendly system wherein a customer can monitor the process of the upsell offering procedure on the display device of the POS terminal, that is, the display/screen of the POS terminal is displaying the game procedures such as shown in figure 4-6 of the Cohen wherein such offering is determined according to the probability of Montangero.

Response to Arguments

8. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, identifying products using the barcode symbology is well known in the art for automated processing system.

In response to the applicant argument that "...The reference of record, either alone or in combination, fail to suggest such limitation..." (see page 7, line 1+), the Examiner respectfully provide Walker reference wherein Walker discloses the POS terminal determining an upsell offer according to the product to be purchased by the customer as discussed in paragraph 3 above.

Conclusion


10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday-Friday, 7:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Seung-H Lee
Art Unit 2976
February 07, 2006